

**REMARKS/ARGUMENTS**

In the specification, four paragraphs have been amended to correct minor editorial problems.

The Examiner has objected to the drawings because the reference number 18 was not described in the specification. The first paragraph on page 6 has been amended to address this issue, and the previously omitted reference number 18 has been added to the specification.

The Examiner has noted that a reference to prior Application No. 09/375,840, filed August 16, 1999, and prior Application No. 09/746,447, filed December 6, 2000 should be inserted as the first sentences of the specification if the Applicant intends to rely on the prior filing date under 35 U.S.C. 119(e), 120, 121, or 365(c). The Applicant does intend to rely on such prior filing date and respectfully brings to the Examiner's attention a preliminary amendment, filed on October 30, 2003 with the original application, which requested inserting a reference to the prior applications as the first sentences of the specification. A filing receipt dated February 2, 2004, reflects the entry by the U.S. Patent and Trademark Office. Copies of the preliminary amendment and filing receipt are attached hereto for the Examiner's review.

Claims 28-36, 55 and 56 are pending. In the Office Action, the Examiner rejected claims 28-36, 55 and 56 based on nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of commonly assigned U.S. Patent No. 6,797,051 (the "'051 patent"), which issued on September 28, 2004. The Examiner indicated that the rejection could be overcome by a timely filed terminal disclaimer, provided that the conflicting patent is shown to be commonly owned with this application.

In response, the Applicant submits herewith a Terminal Disclaimer, filed under 37 CFR § 1.321(c), which is attached hereto, disclaiming the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of the '051 patent. The fee for filing a Terminal Disclaimer under 37 CFR 1.20(d) is enclosed.

The Examiner provisionally rejected claims 28-36, 55 and 56 based on nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/457,240 in view of U.S. Patent No. 4,472,201 ("Ochi"). The present application is a child of Application No. 09/375,840, filed in response to a restriction requirement issued in the parent case. Because a double patenting rejection is not permitted where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application, the Applicant respectfully requests the withdrawal of this rejection. MPEP 804.01.

The Examiner rejected claims 28, 32, 33, 35, 36, 55 and 56 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,505,344 ("Woods") in view of Ochi and U.S. Patent No. 5,914,196 ("Calvo"). The Examiner also rejected claim 29 under 35 U.S.C. § 103(a) as being obvious over Woods in view of Ochi, Calvo, and U.S. Patent No. 4,450,253 ("Suk"), and as being obvious over Woods in view of Ochi, Calvo, and U.S. Patent No. 5,500,456 ("Hughett"). The Examiner also rejected claim 34 under 35 U.S.C. § 103(a) as being obvious over Woods in view of Ochi, Calvo, and U.S. Patent No. 4,005,038 ("Minkoff"). The Applicant respectfully traverses the rejections in light of the specification and the arguments below.

The present invention is generally directed to an aerosol surface texture material that is storable as a pressurized liquid or semi-liquid and can be sprayed from an air-tight container onto drywall or other supporting surfaces to patch acoustic ceiling areas. The ingredients allow the material to be sprayed in a more controlled manner and also maintain its form in the presence of volatile organic compound (VOC) propellants without melting or deterioration. One of the ingredients is an aggregate having polyethylene particulates which imparts the property of maintaining form in the presence of VOC propellants.

Woods is generally directed to a sprayable texture material and methods for using the same. The material includes an aggregate to produce an irregular texture when applied to a surface. The aggregate is described as comprising glass and/or ceramic spheres.

Ochi is generally directed to hydraulic heat-resisting cement that can be used in making castable refractories useful in furnace constructing engineering. Ochi describes using foamed material such as foamed polyethylene for "providing the effect of a heat-insulating cement." Col. 3, lines 46-53.

Calvo is generally directed to a sprayable material that is used to create a multicolored coating that can be sufficiently applied in one application. The coating includes hydrophobic fillers that help keep the color particles separate, even when sprayed from a dispenser that uses high shear.

The Examiner rejected independent claims 28, 55 and 56 of the present invention under 35 U.S.C. 103(a) as being obvious over Woods in view of Ochi and Calvo. The Examiner notes that while Woods “does not disclose expressly foamed polyethylene as the aggregate,” that Ochi teaches the use of such polyethylene as an aggregate “for a hydraulic heat-resisting material.” The Examiner states that “[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the foamed polyethylene as the aggregate in the composition of Woods. The motivation to do so would have been to include a shrinkage-resisting agent and to make the composition a lighter weight.”

In reviewing the above references, the Applicant respectfully disagrees that there is a motivation to combine the cited references. Although the Examiner is correct in stating that Ochi discloses the use of polyethylene, Ochi discloses this use in a field of art that is not analogous to that which Woods is in, namely, sprayable texture materials. There is no suggestion to look to a field of art concerning furnace engineering and construction to solve a problem associated with the application of spraying texture or color materials. Furthermore, the purpose for which polyethylene is being incorporated in the present invention is to solve a completely different problem than in Ochi.

The present invention is directed to surface texture materials that can be more controllably sprayed by the user from an aerosol container onto surface areas to create an irregular texture pattern. In the present invention, it is discovered that polyethylene aggregates can produce the desired irregular surface texture, known as the “Popcorn effect,” and unlike the traditional aggregates, can also be used with VOC propellants without melting or deterioration. It is beneficial to use VOC propellants because the alternatives are compressed air or other non-VOC propellants which require increased pressure to properly propel the material. An increase in pressure reduces the control that the user has over the spray and too much material is forced out at once, also reducing its value to the user. Page 9, paragraph 1. Moreover, the polyethylene particulates, due to their soft and deformable material, allow for an easier flow through the valves

and nozzles of the dispensing container because they can deform and bend within these valves and nozzles upon dispensing. Page 4, paragraph 1.

In Ochi, however, polyethylene is included as “a shrinkage restricting agent for providing the effect of an expansion cement, and . . . for providing the effect of a heat-insulating cement.” Col. 3, lines 45-53. There is no suggestion that the polyethylene can be used to create an irregular textured pattern upon being sprayed nor is there any suggestion that polyethylene aggregates will not deteriorate or melt in the presence of VOC propellants. Additionally, Ochi does not disclose nor suggest that polyethylene properties would allow for easier flow of a material through aerosol dispensers. The invention in Ochi does not even discuss sprayable materials.

“In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992); see also *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858 (Fed. Cir. 1993); and *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069 (Fed. Cir. 2003). Thus, it was improper to modify Woods with Ochi because they are neither in analogous art nor reasonably related in the problem that is being addressed.

In fact, the properties that Ochi cites as desirable would teach away from including polyethylene in Woods to meet the present invention. Ochi states that polyethylene is desirable for its ability to restrict shrinkage and to insulate heat. Col. 3, lines 45-53. Because the surface texture material of Woods is dispensed through an aerosol spray, including an aggregate that does not shrink or deform would not be desirable. If the aggregate maintained its shape with without any flexibility, the material would not be dispensed in a uniform spray and would increase clogging. Furthermore, the disclosure of Ochi teaches away from the incorporation of polyethylene in Woods due to the fact that polyethylene is described in Ochi as a heat-insulating material. Sprayable materials, dispensed in a manner like the present invention, would want to avoid heat-insulating materials because any increase and/or retention of heat would increase the internal pressure of the dispenser and consequently lead to a reduced level of user spray control. As described in the disclosure of the present invention, increased pressure forces the sprayable material to be dispensed all at once in a matter of seconds, which offers the user little value. It is

improper to combine references where references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983).

Accordingly, the Applicant respectfully submits that independent claims 28, 55 and 56 are not obvious over the above cited references.

Claims 29-36 are directly dependent from independent claim 28. Accordingly, the Applicant respectfully submits that claims 29-36 are not obvious over the above-cited references for the reasons set forth above with respect to independent claim 28.


This response is being submitted within the three month deadline. In the case any fee is owed, please charge deposit account number 16-1805 (ref. 81168-306630).

The Applicant believes that claims 28-36, 55 and 56 are now in condition for allowance, and a favorable action is respectfully requested. If, for any reason, the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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**PATENT**  
**81168-306630**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re divisional application of:	)	Art Unit: unassigned
JOHN R. WOODS	)	
	)	Examiner: unassigned
Serial No.: Unassigned	)	
Filing Date: October 30, 2003	)	
	)	
For: MORE CONTROLLABLE	)	
ACOUSTIC PATCH SPRAY	)	
COMPOSITION	)	

**PRELIMINARY AMENDMENT**

Asst. Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Prior to examination of the above-referenced application, please consider the following remarks and amendments:

**IN THE SPECIFICATION:**

Please add the following paragraph below the Title of the Invention Section:

This application is a divisional of U.S. Patent Application No. 09/746,447, entitled "More Controllable Acoustic Spray Patch Composition," filed December 6, 2000, which is a divisional of U.S. Patent Application No. 09/375,840, entitled "More Controllable Acoustic Spray Patch Composition," filed August 16, 1999, now abandoned, both of which are herein incorporated by reference.

**IN THE CLAIMS**

Please cancel claims 1-27 and 37-54, without prejudice, amend claims 30 and 31 as shown, and add claims 55-56. The pending claims are as follows:

1-27. Cancelled

28. A hardenable flowable substance for application to a patch surface surrounded by an acoustic ceiling material having an irregular surface texture to form a layer of textured patch material on the patch surface, wherein the hardenable flowable substance is storable in a fluid-tight dispensing container and sprayable utilizing a volatile organic compound (VOC) propellant, the hardenable flowable substance comprising:

- a liquid base;
- a filler selected to form an extender or bodifier for the resulting patch material;
- an adhesive binder selected to adhere the resulting patch material to the surface;
- an aggregate comprising polyethylene particulates that does not decompose in the presence of VOC propellants, selected to give the resulting patch material an irregular surface texture;
- an anti-foaming agent; and
- a suspension agent,

wherein the hardenable flowable substance is initially stored in fluid state and is dispensable in the form of an aerosol spray from the fluid-tight container and, after being released and curing, forms a bumpy, irregular surface texture that matches and is compatible with the acoustic ceiling material surrounding the patch.

29. The hardenable flowable substance according to claim 28, having the following composition by percentage weight:

- the liquid base of 20-70%;



the filler of 40-80%;  
the adhesive binder of 1-50%;  
the propellant of 5-20%;  
the aggregate of 2-40%;  
the anti-foaming agent of 1-10%; and  
the suspension agent of 1-20%.

30. The hardenable flowable substance according to claim 29, wherein:

the liquid base consists essentially of water;  
the filler consists essentially of a mixture of calcium carbonate and mica;  
the adhesive binder consists essentially of polyvinyl alcohol;  
the propellant consists essentially of dimethyl ether;  
the polyethylene particulates of the aggregate are open-cell;  
~~the anti-foaming agent consists essentially of Wichenol;~~ and  
the suspension agent consists essentially of carbonal.

31. The hardenable flowable substance according to claim 29, wherein:

the liquid base consists essentially of a solvent;  
the filler consists essentially of a mixture of calcium carbonate and mica;  
the adhesive binder consists essentially of polyvinyl alcohol;  
the propellant consists essentially of dimethyl ether;  
the polyethylene particulates of the aggregate are open-cell;  
~~the anti-foaming agent consists essentially of Wichenol;~~ and  
the suspension agent consists essentially of carbonal.

32. The hardenable flowable substance according to claim 28, further comprising:

a fungicide.

33. The hardenable flowable substance according to claim 28, further comprising:  
an anti-freeze.

34. The hardenable flowable substance according to claim 33, wherein the anti-freeze consists essentially of ethylene glycol.

35. The hardenable flowable substance according to claim 32, wherein the fungicide as a composition by percentage weight of 0.05-5%.

36. The hardenable flowable substance according to claim 33, wherein the anti-freeze has a composition by percentage weight of 1-10%.

37-54. Cancelled

55. A hardenable flowable substance storable in a fluid-tight dispensing container and sprayable utilizing a volatile organic compound (VOC) propellant, the hardenable flowable substance comprising:

a liquid base;

a filler selected to form an extender or bodifier for the resulting patch material;

an adhesive binder selected to adhere the resulting patch material to the surface;

an aggregate comprising polyethylene particulates that does not decompose in the presence of VOC propellants, selected to give the resulting patch material an irregular surface texture;

an anti-foaming agent; and

a suspension agent,

wherein the hardenable flowable substance is initially stored in fluid state and is dispensable in the form of an aerosol spray from the fluid-tight container and, after

being released and curing, forms a bumpy, irregular surface texture that matches and is compatible with the acoustic ceiling material surrounding the patch.

56. A hardenable flowable substance for application to a patch surface surrounded by an acoustic ceiling material having an irregular surface texture to form a layer of textured patch material on the patch surface, wherein the hardenable flowable substance is storable in a fluid-tight dispensing container and sprayable utilizing a propellant, the hardenable flowable substance comprising:

- a liquid base;

- a filler selected to form an extender or bodifier for the resulting patch material;

- an adhesive binder selected to adhere the resulting patch material to the surface;

- an aggregate selected to give the resulting patch material an irregular surface texture, the aggregate comprising polyethylene particulates;

- an anti-foaming agent; and

- a suspension agent,

wherein the hardenable flowable substance is initially stored in fluid state and is dispensable in the form of an aerosol spray from the fluid-tight container and, after being released and curing, forms a bumpy, irregular surface texture that matches and is compatible with the acoustic ceiling material surrounding the patch.

**REMARKS**

Claims 28-36, and 55-56 are pending in the present application. Claims 1-27 and 37-54 have been cancelled. Claims 30 and 31 have been amended. Applicant has elected Group IV, claims 28-36. New claims 55-56 have been added. No new material has been added.

Applicant believes that the foregoing amendments place this application in condition for allowance. As such, early, favorable action on the merits is requested. If for any reason the Examiner finds the Application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing this application in condition for allowance.

The commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment associated with this Response, to Deposit Account No. 16-1805.

Respectfully submitted,

Date: October 30, 2003

By: 

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